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MP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/263,083	03/08/99	NOGUCHI	H 35.C13382

005514 IM22/0525
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

WU, S

ART UNIT	PAPER NUMBER
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1756

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DATE MAILED: 05/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/263,083

Applicant(s)
Noguchi et al.

Examiner
Shean C. Wu

Group Art Unit
1756



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 8-11 is/are rejected.

☒ Claim(s) 2-7 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1756

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/263,083, filed on 3/8/99.
2. Claims 1 and 8-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the fluorine-containing epoxy resin compositions having in one molecule at least one perfluoroalkyl group of 6 to 12 carbon atoms and at least two alicyclic epoxy group and a cationic catalyst which are exemplified in the specification, does not reasonably provide enablement for other fluorine-containing epoxy resin compositions beside those disclosed in the specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. There are no general guidelines how to prepare the present fluorine-containing epoxy resin except those disclosed in the specification.
3. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wu whose telephone number is (703) 308-3956. This examiner can normally be reached on Monday through Friday from 9:30 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Sharon Gibson, can be reached on (703) 308-4552. The group 1756 FAX machine numbers are (703) 305-5408 or 703-305-3599 (2nd Fax number is designated for Office Action After Final). Unofficial correspondence transmitted by FAX must be marked "DRAFT". All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1756 receptionist whose telephone number is (703) 308-0661.


SHEAN C. WU
PRIMARY EXAMINER
GROUP 1200